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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/736,631	12/17/2003	Hiroaki Imai	500.433-40X00	3845
20457 7590 07/17/2008 ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873				
EXAMINER				
AMSDOLL, DANA				
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3627				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/736,631

**Applicant(s)**

IMAI ET AL.

**Examiner**

DANA AMSDELL

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Acknowledgements**

This Office action is in response to Application Number 10/736631 filed 12/17 2003.

This Office action is given paper number 20080710 for reference purposes only.

Claims 1- 13 are pending.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8 and 9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 recites "a program for causing a computer to execute..." However, this is merely software, and it has been held that software without a required computer-readable medium storing the software that, when executed, causes the computer to perform a particular process or method (MPEP 2106.01) is merely nonfunctional descriptive material and non-statutory under 35 U.S.C. 101.

Claim 9, although providing a "computer readable recording medium" for the program of claim 8, does not necessitate that the program be actually executed by a computer and therefore is non-statutory under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Nagata, (US 2002/0077979), here-in-after “Nagata”.

5. Regarding claim 1, 7, 8 and 9, Nagata teaches for providing appropriate services by a computer to a user of a repeated use of a product such as a commodity vessel or a commodity comprising:

- the computer receiving from a reader/writer section which has performed reading from a writable storage medium attached to the product presented by the product user, the storage information of the writable storage medium acquired by the reading operation (see fig. 1, block 10 representing “the computer”, elm. 5 being “a reader/writer section”, elm. 60/61 being “a writable storage medium attached to the product presented to the product user (see pg. 22, ¶[0411] ),
- recognizing the use history of the product from the storage information acquired (fig. 35, elm. 92),
- judging the service content by checking the use history recognized in a table where service content is defined according to the number of repeated uses of the product (fig. 76(a), ‘recycle round’),

- executing a processing according to the service content judged and outputting the processing result to an output apparatus (pg. 13, ¶ 0264, fig. 76(a) and pg. 56, ¶ [1055], and fig. 89, elm. 125).

6. Regarding claim 2, Nagata teaches providing services in recycling products according to claim 1, instructing the reader/writer section to write a use history in the writable storage medium according to a commodity or a service when the presentation of the product by the product user is upon a commodity or service purchase accompanied by the repeated use of the product (fig. 34, steps 30, 37 and 38 and fig. 78(c)).

7. Regarding claim 3, Nagata teaches providing services in recycling products according to claim 1, comprising attaching a writable storage medium to the product presented upon purchase of the commodity or service if the product has no writable storage medium, and a step of instructing the reader/writer section to write the use history to the attached writable storage medium according to the commodity or service purchase content (fig. 33 and pg. 32, ¶ [0578]).

8. Regarding claim 4, Nagata teaches providing services in recycling products according to claim 2, further comprising attaching a writable storage medium to the

product presented upon purchase of the commodity or service if the product has no writable storage medium, and instructing the reader/writer section to write the use history to the attached writable storage medium according to the commodity or service purchase content (pg 32, ¶ [0573]).

9. Regarding claim 5, Nagata teaches providing services in recycling products according to claim 1, further comprising providing a product having a writable storage medium if no product is presented by the product user upon purchase of the commodity or service, and instructing the reader/writer section to write the use history into the writable storage medium attached to the provided product according to the commodity or service purchase content (figs. 9(a), 10(a) and pg. 16, ¶ [0314]).

10. Regarding claim 6, Nagata teaches providing services in recycling products according to claim 2, comprising providing a product having a writable storage medium if no product is presented by the product user upon purchase of the commodity or service, and a step of instructing the reader/writer section to write the use history into the writable storage medium attached to the provided product according to the commodity or service purchase content (figs. 9(a), 10(a), pg. 16, ¶ [0314] and [0315]).

11. Regarding claim 10, Nagata teaches a device for providing services to a user who is repeatedly using a vessel for containing a commodity to purchase the commodity

(pg. 50 ¶ [0933]), said device comprising a computer section, a reader/writer section connected to the computer and capable of reading/writing information stored in a readable/writable storage medium, and a memory section connected to the computer and capable of storing services to the user having different contents according to a number of repeated uses of the vessel, wherein when the reader/writer section detects the readable/writable storage medium attached to the vessel, the computer section calculates a latest number of repeated uses of the vessel from the information in the readable/writable storage medium attached to the vessel, and the computer section decides a service to be provided to the user corresponding to the latest number of repeated uses by referencing the memory section (fig. 55, fig. 62 and pg. 54, ¶ [0998]).

12. Regarding claim 11, Nagata teaches a device for providing services to a user according to claim 10, wherein the computer section reads a number of repeated uses of the vessel in the past from the information in the readable/writable storage medium attached to the vessel and overwrites the latest number of repeated uses on the number of repeated uses of the past in the readable/writable storage medium (fig 67(a) and pg. 54, ¶ [0996]).

13. Regarding claim 12, Nagata teaches a device for providing services to a user according to claim 10, wherein the readable/writable storage medium is embedded in thickness of the vessel (fig. 17(b) and pg. 25 ¶ [0452]).

14. Regarding claim 13, Nagata teaches a device for providing services to a user according to claim 10, wherein the computer section executes processing to attach a readable/writable storage medium to the vessel when the reader/writer section does not detect a readable/writable storage medium attached to the vessel (fig.33, step 23).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is following:

- a. Armstrong et al., (US 5627973)
- b. Tani et al., (US 6,529,788)
- c. Iihoshi et al., (US 6,754,570)
- d. Tsunenari, (US 7,069,236)
- e. Hiroshige et al., (US 2002/0069137)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANA AMSDELL whose telephone number is (571)270-5210. The examiner can normally be reached on 5/4/9.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DANA AMSDELL/  
Examiner, Art Unit 3627

7/15/2008

/F. Ryan Zeender/  
Supervisory Patent Examiner, Art Unit 3627